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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,242	12/06/2000	David M. Kranz	89-99	8588

23713 7590 03/19/2002

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5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER, CO 80303

EXAMINER

GUZO, DAVID

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 03/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/731,242

Applicant(s)

KRANZ ET AL.

Examiner

David Guzo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: *301a & 301b*

**Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to methods of using high affinity TCRs to identify ligands, classified in class 435, subclass 7.1.
- II. Claims 6-10, drawn to methods of using high affinity TCRs as diagnostic probes in vitro or in vivo, classified in class 424, subclass 9.1.
- III. Claim 11, drawn to a method for blocking autoimmune destruction of cells, classified in class 514, subclass 2.
- IV. Claim 12, drawn to a method for treating neoplastic disease, classified in class 424, subclass 184.1.
- V. Claims 13-14, drawn to a method for using high affinity TCRs to inactivate pathogens, classified in class 424, subclass 185.1.
- VI. Claims 15-18 and 20, drawn to soluble high affinity TCRs and a library of TCRs displayed on the surface of yeast cells, classified in class 530, subclass 350.
- VII. Claim 19, drawn to a DNA library encoding TCRs, classified in class 536, subclass 23.5.
- VIII. Claims 21-24, drawn to a method for cloning a gene for a high affinity TCR, classified in class 435, subclass 455.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve distinct method steps which are directed to distinct, unrelated, outcomes (e.g. identifying ligands vs. diagnostic probes). A search of one invention would not be co-extensive with a search of the other and hence would be burdensome. Each invention is capable of supporting a separate patent.

Inventions II, III, IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions read on different, distinct, inventions each involving distinct steps with different compositions (i.e. TCRs bound to an anti-neoplastic compound or TCRs bound to a toxin effective against a pathogen, etc.) and each directed to a patentably distinct outcome. A search of each group would not be co-extensive with a search of the other and would be burdensome. Each invention is capable of supporting a separate patent.

Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve different biochemically, structurally and functionally distinct molecules (proteins vs. DNA) with each capable of supporting separate patents.

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Inventions II and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve totally distinct, unrelated, methods with each method directed to an unrelated outcome (i.e. diagnosis vs. a method of cloning a gene). A search of one invention would not be co-extensive with a search of the other and hence would be burdensome. Each method is capable of supporting a separate patent.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**It is noted that the claims (originally numbered as 1-23) have been renumbered as 1-24 because two claims were numbered as claim 19.**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo whose telephone number is (703) 308-1906. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding or relating to attachments to this Office Action should be directed to Patent Analyst Zeta Adams whose telephone number is (703) 305-3291.

David Guzo  
March 18, 2002

DAVID GUZO  
PRIMARY EXAMINER  
*David Guzo*